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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,896	09/25/2003	Eric Welch	356575.00020	7991

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REED SMITH, LLP
TWO EMBARCADERO CENTER
SUITE 2000
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EXAMINER
NGUYEN, VAN KIM T

ART UNIT	PAPER NUMBER
2152	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/671,896

Applicant(s)

WELCH, ERIC

Examiner

Van Kim T. Nguyen

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) 8-80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date November 1, 2004.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is responsive to communications filed on September 25, 2003.

Claims 1-80 pending in the case.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to a network controller structure, classified in class 709, subclass 220.

- II. Claims 8-20, drawn to a method of operating a host computer, classified in class 709, subclass 218.

- III. Claims 21-26 and 58-60, drawn to establishing a TCP connection, classified in class 709, subclass 227.

- IV. Claims 27-38, 40-43 and 73-76, drawn to detecting network connection, classified in class 709, subclass 224.

- V. Claims 45-55, drawn to network security, classified in class 713, subclass 100.

- VI. Claims 61-80, drawn to configuring transmission data, classified in class 709, subclass 230.

3. During a telephone conversation with Applicant's representative, Doyle Johnson on August 28, 2007 a provisional election was made without traverse to prosecute the invention of group I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-80 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The inventions are distinct, each from the other because of the following reasons:

i. Inventions I to VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination 1 through IV has separate utility such as a network controller structure, a method of operating a host computer, establishing a TCP connection, detecting network connection, network security and configuring transmit data, respectively . See MPEP § 806.05(d).

ii. The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claims depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a).

iii. Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

iv. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Claim Objections

4. Claims 2-3 are objected to because of the following informalities:

Claims 2-3 disclose the limitations "The host controller according the Claim 1 ---", see line 1. It probably should read "The host controller according to Claim 1---".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-4 recites the limitation "The host controller" in line 1 of each of the claims. There is insufficient antecedent basis for this limitation in the claims since "The host controller" has not been introduced prior to the recitation of this limitation.

Claims 5-6 are dependant claims of claim 2, thus rejected under the same basis.

Claim 4 calls for "configured to implement USB 10.2 Host Controller requirements", see lines 1-2. It is not clear what USB 10.2 Host Controller requirements are since applicant fails to further define the limitation.

Art Unit: 2152

Claim 7 recites the limitation “The stand alone USB host controller“ in line 1. There is insufficient antecedent basis for this limitation in the claim since “The stand alone USB host controller“ has not been introduced prior to the recitation of this limitation.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Wooten (US 5,832,492).

Regarding claims 1 and 4, as shown in Figures 1-2, Wooten discloses a host controller (100), comprising:

a network interface (USBI, 204; Figure 2);

a bus and at least one external port coupled to the bus (e.g., bus that connects host controller 130 to either port 132, 134 or 136; Figure 1); and

a processor coupled to the bus and the network interface and configured to process communications passed between the network interface and the bus (host controller 130 coupled to the USBI and USB Device 204 and configured to process communications passed between the USB Device and the bus; col. 6: lines 38-49).

Regarding claim 2, Wooten also discloses the bus is a USB bus, the external port is a USB port, the communications are USB device related communications (a printer 132 is connected to one port of the serial bus host controller 130; col. 2: lines 55-67; col. 5: lines 5-7).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3 and 5-7 rejected under 35 U.S.C. 103(a) as being unpatentable over Wooten as applied to claim 1 above, in view Lawande (US 6,842,797).

Wooten does not explicitly call for the network interface being one of an Ethernet port, a Wi-Fi or other wireless connection, an

Lawande teaches the network interface is at least one of an Ethernet port, a Wi-Fi or other wireless connection, LAN connection, and an internal interface to another system that provides network connection services (port connected to Ethernet device or other burst communication device; col. 4: lines 4-17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply include Lawande's different type ports in Wooten's system in order to provide a more versatile communication network system that can connect different networking media/platforms.

Regarding claims 5-6, Wooten also discloses a bus driver configured to facilitate transfer of the data and commands

However, Wooten does not explicitly call for configuring an IP stack to work in conjunction with the communications being received and sent via the network interface.

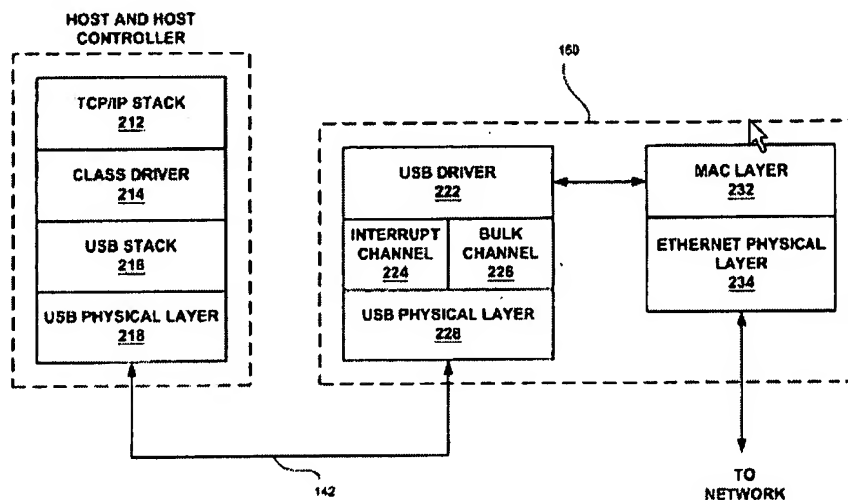


FIGURE 2

As shown in Figure 2, Lawande discloses the processor is configured to operate an IP stack configured to work in conjunction with the communications being received and sent via the network interface (col. 3: lines 54 –67).

Lawande also discloses a transaction server coupled to the IP stack and configured to process a set of messages passed to/from the IP stack and from/to the bus (a Host coupled to a Host Controller, see Figure 2).

Since TCP/IP is perhaps the most utilized protocol in the networking arena, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an IP stack to work in junction with the communication being facilitated via the network interface in order to provide a more versatile communication network system that can connect different networking media/platforms.

Regarding claim 7, Lawande also discloses the set of messages comprise at least one of Logon/Logoff, attach/detach, reset endpoint, and data transaction messages (skip bit, Halted bit; col. 7: lines 44-58; or interrupt/reply messages; col. 11-12).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Smart Card Device and Method used for Transmitting and Receiving Secure E-Mails; Tamagno et al (US 7,178,724);

Wireless Cable Replacement for Computer Peripherals Using a Master Adapter; Bartek et al (US 7,136,904);

System and Method for Connecting a Universal Serial Bus Device to a Host Computer System; Burke et al (US 7,043,587);

Data Playing System, Transmitting and Receiving Apparatus, and Bus Conversion Unit; Okamoto (US 6,965,954);

USB Adapter for Burst Mode Communications, Lawande (US 6,842,797);

Method and Apparatus for Switching Among a Plurality of Universal Serial Bus Host Devices; Evans et al (US 6,600,739);

Art Unit: 2152

Apparatus and Method for Securing Information Entered upon an Input Device coupled to a Universal Serial Bus; Rawlins (US 6,216,183); and

Method and System for Accurate Temporal Determination of Real Time Events within a Universal Serial Bus System; Chambers et al (US 6,012,115).

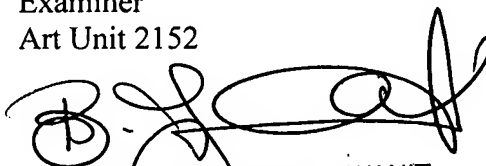
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Van Kim T. Nguyen whose telephone number is 571-272-3073. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

vkn

Van Kim T. Nguyen
Examiner
Art Unit 2152


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SUPERVISOR BY PATENT EXAMINER
9/27/7